



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/775,418	10/15/91	MCMASTER	H GLT-1225-R

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SCHOR.K

ART UNIT	PAPER NUMBER
1303	3

DATE MAILED: 04/14/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-20 are rejected.
5. ☒ ~~Claim~~ The reissue declaration is objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
A letter requesting transfer of the drawings from the patent file would deal with this
see MPEP 1413
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

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35 USC 112 Rejections

Claims 1-7, 10-12 and 17-20 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to both drive and idler rollers, i.e. drive and idler wheels. The disclosed invention simply will not work without it. Also, there is not one shred of disclosure which advises omitting it. The disclosure needs the rollers (wheels) to advance the glass. See M.P.E.P. §§ 706.03(n) and 706.03(z).

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure and failing to provide support for the invention as now claimed.

First it is noted that the disclosure contains no enablement for the broad scope of claims 17-18. Claims 17-18 only require two platens with "quench openings", nothing more. There is no disclosure support for this, as the inventive apparatus.

As to claim 20, the combination of the oven, load-conveyor for

transporting glass into the oven, longitudinal rows of quench tubes on lengthwise extending ~~and~~ support bars, cooling section, cooling section rollers and power means (the third set of power means); is simply not supported nor enabled by the original disclosure. Also, many of the specifics of the individual limitations are not supported nor enabled.

Page and line support together with how the lines provides support (using the quotes from the patent) is required for a complete response. Or alternatively, applicant could simply delete claim 20. Note that claim 20 can not be used to provoke an interference with another patent, because claim 20 is not even close to being supported by the present disclosure; yet claim 20 would need to be completely supported (and be otherwise patentable) in order to provoke an interference.

For claim 19 there is no original disclosure support for quench portions of platens opposing each other. The quench "portions" are not shown to be lined up, even if "portion" is interpreted to mean ~~the~~ quench holes..

As to claim 17, there is no enablement for omission of "bending". The entire disclosure is for a "bending and tempering", i.e., "bending and quenching" apparatus. Also, the disclosure does not disclose platens "to receive a bent glass sheet therebetween".

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Page and line support and how supported is required for a complete response. The glass of the invention is flat when it gets to the apparatus, not bent. The glass is bent in the apparatus of the invention.

As to claims 18-19, there is no disclosed "including a deformable quench portion"; the entire platen surface has quench openings 18. Thus, the disclosure is not enabling.

As to claims 17-18, where in the disclosure is the actuator left out ~~anywhere~~? Thus, again claims 17-19 are not enabled.

For claim 20, means are provided to change vertical position of the upper quench tubes, but no means are provided to deal with the position of the upper rollers. Yet, the disclosure requires the upper rollers to be changed as to position together with the lower rollers.

Claims 17-20 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1-16 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention.

For claims 1, 15 and 16, "and quenching gas being supplied" should properly be "means for supplying quench gas to the quench openings" to properly set forth the enabled invention. The claims are incomplete without this means for supplying.

Claims 17-20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 17-19, "therewith" is not clear as to antecedent. Also, "thereof" could refer to either platens or quench openings. "Quench openings" is not clear as to what means is required; a quench ^{opening} can be an opening in the platen through which the glass sheet passes to be quenched. "Opposing...to supply....gas" is not clear; how can platens oppose to supply gas? What does the opposing have to do with permitting the apparatus to supply gas?

For claim 20 "the cooling section" of the last two paragraphs of the claims lacks a claim antecedent. Also, there is not description of where the cooling section might be with respect to the rest of the apparatus.

For claim 20, "the bent glass sheet" lacks a claim antecedent. Also, there is no prior claimed means for bending the glass sheet,

such that the quench tubes/rollers could have the same contour as the bent glass sheet.

For claim 20, "the lower support bar" (singular bar) has no claim antecedent; there are a number of equally low bars provided to support lower quench tubes, but no one bar is lower than the rest.

The amendment filed 10-15-91 via the reissue specification is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has amended column 4 of the patent to provide support for the claims; however, the amendment is new matter and is not supported by the original disclosure. There is no original disclosure that the quench openings of the two platens oppose each other i.e., are opposite each other. The original disclosure did not disclose the openings lining up for the two platens.

(col. 4 line 58)

Also, "that defines a quench portion" is not clear whether it refers to the "platen", surface 20, or "quench openings". There is no disclosure (original) of any of the three defining "a quench portion of the platen". In fact, page 2 of Ex. Kellogg's 1-24-89

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Ex Parte Quayle, Office action points out that the quench openings are "spaced throughout both platens to permit blast tempering...". Applicant could have commented ^{in response to the Quayle action} that "throughout" was wrong and "a portion" should have been there instead. But applicant did not. Also, the disclosure does not support the "portion" insertion.

Applicant is required to cancel the new matter in the response to this Office action.

Claims 1-20 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The col. 4 additions affected the claims scope to the extent that the opposing quench openings will be read into any of the claims. Also, the "quench portion" is used in a number of the newly presented claims, i.e., 17-19.

General Objection To Declaration

The reissue oath or declaration filed with this application is defective because it fails to comply with the requirements of 37 CFR 1.63 as required C.F.R. § 1.175(a).

The declaration fails to provide the residence of each inventor by at least city and state. Also, the post office address of each is missing. Also, the inventors are identified as "sole inventors of the invention". Also, the declaration did not state

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anywhere that it was attached to the specification, yet such would be required for an original declaration. Accordingly, a proper substitute declaration will be required.

Specific Reissue Insufficiencies

The reissue oath or declaration filed with this application is defective because it fails to particularly specify (1) the excess or insufficiency in the claims, as required under 37 CFR 1.175(a)(3) and (2) the defects in the specification as required under 37 CFR 1.175(a)(2).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

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The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

As to the new claims, the reissue declaration merely defines generally what each new claim calls for. That is not enough, and the above three paragraphs must be complied with.

As to the specification, the reissue declaration points out the defects by incorporation by reference. However, the reference in the declaration to incorporate Exhibits 1 and 2 (which were

filed with the case) is not sufficient; the defects must be set forth in the declaration itself (the body of the declaration). The recitation of the defects must be followed by the signature of the inventors at the end of the declaration. The second and third paragraph of this section have not been complied with at all as to the defects.

As to claim 20 it is also added that claim 20 was copied for purposes of "provoking an interference". However, such does not recite error.

With regard to this section of the Office action, it should also be noted as follows. The failure to omit a limitation is not error, where the claims can only be enabled (supported) with the limitation present. Also, claims directed to an invention different from that of the patent are not proper for the filing of a reissue application (MPEP 1412.01 and 1450).

Applicant must submit a substitute reissue declaration specifying what is called for above, ^{so} ~~and~~ that it can be determined whether this application is indeed a proper reissue application.

35 USC 251 Rejection

Claims 1-20 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

The above rejection is based upon all the informalities noted

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1 in both the "General Objection To Declaration" and "Specific Reissue Informalities" sections of this Office action.

Wholly or Partly Inoperative

The reissue oath or declaration filed with this application is defective because it fails to contain a statement that the applicant believes the original patent to be wholly or partially inoperative or invalid, as required under 37 C.F.R. § 1.175(a)(1).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

The declaration states "inoperative" rather than "inoperative or invalid" as required by MPEP 1414.01.

Also, since the patent is "inoperative" in its present form, that means that the claims 1-16 patent invention will not operate. In view of this what is the error as to inoperative (as opposed to invalid)? Why won't the patent claims operate?

Claims 1-20 are, for the reasons set forth in this section, rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Consent of Assignee

This application is objected to under 35 U.S.C. § 251 as lacking the written consent of all assignees owning an undivided

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interest in the patent.

Glasstech, Inc. has consented to the present reissue application; however, GLT Corp. is the assignee shown by the title search. Thus, a further consent document is required.

Prior Art Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 17-19 are rejected under 35 U.S.C. § 102(b) as

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anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Yoshizawa, Nushi, or McMaster '854.

It would have been, to the skilled artisan, either obvious or inherent that the structure of the applied prior art will meet that of the claims, and carry out the function of the claimed means. Note Yoshizawa col. 3 lines 7-19. Note that the "permeable" felt sheet of Yoshizawa will have quench openings, and the claims do not require a given size. Also, Yoshizawa teaches that holes may be present. Figures 1-3 of Yoshizawa are especially relevant. As to McMaster '854 note figures 1-2 with the explanation at col. 4. Blower ^{unit} ~~limit~~ 28 is a means which could be operated reversibly. Also, plenum 26 is a means to supply quench gas, and openings 24 are quench openings since quench gas can be put through them. Thus the structure of the claims is met. It is also obvious that the ^{Yoshizawa/McMaster} structure can be used to do the same functions as the claimed structure does, because claims 17-19 provide the same structure (due to the broad scope of claims 17-19). Nushi figures 3-5 show quench openings. Both Platens 5 and 6 of Nushi have the quench holes; note col. 5 lines 4-6 of Nushi.

Claims 1-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Nushi or Yoshizawa both when taken with any of Classen ('751 or '577) or Benzombes.

Nushi or Yoshizawa teaches two platens for bending glass sheet, which have tempering openings. It would have been obvious to provide actuators that will shape the platens of Nushi or Yoshizawa to permit different shapes of glass to be made via the Nushi or Yoshizawa platens, since Classen '751 and '577 and Bezombes teach such conventional for glass bending molds.

Double Patenting

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 1-20, and 1-11, respectively of U.S. Patent No. 4822398, 4957531, or 4909824, all to McMaster; alone or when further taken with Bezombes or Classen ('751 or '577). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following.

As to the '531 and '824 patents, the heating means and the actuators which they add respectively are not precluded by the present claims which are "comprising" in scope.

The only thing missing from the '398 and '531 patents is the explicit statement that the actuators are "constrainable"; however it would have been obvious to constrain the actuators after they have been set as to distance, so that the contour (provided) will remain uniform. This will permit a plurality of glass objects of

the same contour to be made. Also, Bezombes and Classen '751 or '577 teach that it is conventional to constrain the actuators after a contour has been established.

The three McMaster patents are not of the exact same scope of the present claims; thus statutory (same-type) double patenting does not apply. However, "obvious-type" d.p. clearly does apply here. For the '398 patent a regular terminal disclaimer will be needed, to disclaim as to both term and ownership. The '531 and '824 patents however have a later expiration date than the present claims, thus, only common ownership need be required. As a general statement, the following applies:

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

The double patenting rejection does not apply to claim 20, because claim 20 recites a number of very different limitations which are not claimed by the McMaster patents and are not obvious from the McMaster claims, and are not supported by the McMaster disclosures nor by the present disclosure.

Claim 20 remains patentable over the art; however it is not

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supported by the present disclosure and it has informalities as discussed above.

Other Art Citations

The prior art cited in the prosecution of the patent is again made of record.

In addition, Revells teaches oven and cooler with associated rollers for each, in combination with bending section. Kahle and Keller '701 teach conveyor roll and cooling expedients as disclosed by applicant.

As to Revells, note figure 1; Boyles Figs. 2-3 show that Revells members 86 are deformable, and conform to shape of glass sheet to be bent.

Websters is cited to make it clear that a platen is a flat metal plate, unlike the situation of claim 20. Note also Freidel where a flat plate is not used.

Different Invention Is Not Error

Claims 17-20 are rejected under 35 USC 251 as not being directed to error and not being for the invention in the original patent. Rather, claims 17-20 provide a new and different invention from what was claimed in the patent. See also MPEP 1412.01 and 1450. The declaration is also objected to under 3⁷₈ CFR 1.175(a) as failing to state error. It was not error to omit an invention

which is independent and distinct from the patent claims.

Claim 17 is directed to a tempering apparatus, rather than the bending and tempering apparatus of the patent claims. Claim 17 receives a bent glass sheet while the system of the patent claims 1-16 receives a straight glass sheet.

Claims 18-19 are directed to apparatus having a quench portion, while the patent claims have "quench openings throughout the extent" of the platens. Exr. Kellogg stated at page 2 of the Quayle action in the prosecution of the patent that the "Invention resides within the overall construction of a combined glass sheet bending ^[A] tempering apparatus including an upper ^[A] lower shaping platen with at least one ^[C] platen being deformable to shape a glass sheet between both platens and with quench openings spaced throughout both platens to permit blast tempering of the glass sheet after shaping." (underline added). Applicant is trying to now add a different invention to the patent, where the platens have a quench portion; such is not the "error" appropriate for reissue.

(Claim 18 seeks to go even further from the invention of the patent by not having an actuator in the system; such is clearly not the disclosed invention of the patent. Claim 19 seeks to add a totally new aspect of quench portions being opposed to each other. Again, this is not the invention of the patent claims and disclosure.

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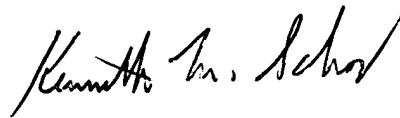
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Claim 20 is directed to a complicated combination which is very different from what is in the patent claims. Claim 20 has many different elements not found in the patent claims; the patent claims have a number of limitations not found in claim 20.

Conclusion

A number of different objections and rejections have been made in this reissue application, because of the nature of and requirements of a reissue application. In the event applicant wishes to continue prosecution in this application, a full response to each will be needed, so as to deal with all the questions raised by this reissue application.

Any inquiry concerning this communication should be directed to Kenneth M. Schor, Primary Patent Examiner - Group 130, at telephone number (703) 308-3606.



KENNETH SCHOR
PRIMARY EXAMINER
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4/14/92

Schor/ad
April 07, 1992